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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,516	08/20/2003	Steven K. MacLeod	01288/2/US	5971

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EXAMINER

DEAK, LESLIE R

ART UNIT PAPER NUMBER

3761

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Drawings

1. The drawings were received on 20 January 2006. These drawings are objected to. While the replacement drawing corrects the objections noted in the Office Action mailed 20 October 2005, the replacement FIG 2 is unclear, since the figure overlaps the reference numerals on the right side, rendering the designations unclear.
2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,089,432 to Crankshaw et al. Crankshaw discloses the invention substantially as claimed in the specification and the figures.

In particular, Crankshaw discloses the structure of a vial 11 with two chambers 13, 14 a stopper 17 intermediate the chambers, and an upper stopper 23. Crankshaw discloses that movement of the upper stopper is an actuating means that pushes the intermediate stopper out of its seal with the constricted portion 16 of the vial, allowing the contents of the two chambers to mix within the combined volume of the two chambers. Crankshaw further discloses the cap 44 over the top of the stopper, a thin wall of the stopper for needle piercing, and the connections, sleeves, and locks of the claimed vial (see, generally, columns 2-4).

Crankshaw fails to disclose that the upper chamber is filled with an aqueous medium and the lower chamber is filled with a gaseous medium. Crankshaw does teach, however, that the purpose of the two-compartment vial is to provide a stable storage solution wherein two substances, which may include a medication, may be stored completely independently from one another. Such independent storage is used when the combination of the substances in the first and second vials reduces the

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stability and shelf life of the combined solution or medicine. Crankshaw discloses that in a preferred embodiment, the upper compartment is filled with a powdered medication and the lower chamber is filled with a solvent. However, Crankshaw specifically discloses that the preferred embodiment is only one utilization of the invention, thereby contemplating other solutions or compositions in the chambers of the vial (column 3, lines 42-45). Furthermore, it has been held that a) the mere reversal of the essential working parts of a device involves routine skill in the art, and b) omission of an element and its function in a combination where the remaining elements perform the same function as before involves only routine skill in the art. See MPEP § 2144.04.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a medicament in solution in one chamber, separated from a dehydratory gaseous medium (absent any lyophilized medicament) in the other chamber, as claimed, since the separation of the two components until just before use improves the stability and the shelf life of the mixed solution, as taught by Crankshaw.

5. Claims 5-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,089,432 to Crankshaw et al in view of US 6,481,435 to Hochrainer et al.

Crankshaw discloses the device substantially as claimed with the exception of the contents and relative formulations of the medicament within the vessel.

Hochrainer discloses that steroids such as, for example, clobetasol and meprednisone, among others, are often packaged in two-chambered dispensing vials in

suspensions for administration to a patient in various concentrations (see column 4, lines 5-12, 38-50, columns 5-6).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to supply the vial disclosed by Crankshaw with a desired medicament for a particular medical treatment, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. See MPEP 2144.07, citing *In re Leshin*, 125 USPQ 416. Applicant has not provided any evidence of unexpected results with regard to the storage or use of the particularly claimed medicament compositions. Accordingly, Hochrainer clearly shows the use of medication, as noted above, a person of ordinary skill in the art would recognize that medication having the particular material claimed would be used in the medicament storage and dispensing vial disclosed by Crankshaw, absent any showing of such new and unexpected results over the prior art.

Response to Arguments

6. Applicant's amendment filed 20 January 2006 has been entered and considered.
7. Applicant's arguments filed 20 January 2006 have been fully considered but they are not persuasive.
8. Applicant argues that the vial disclosed by Crankshaw operates in a different way to achieve a different result than the instantly claimed vial and that the devices are not

functional equivalents. However, examiner did not use the doctrine of equivalents, but rather an allegation of *prima facie* obviousness to reject the instant invention.

Applicant claims a vial that is structurally identical to the vial disclosed by Crankshaw. The difference between the two vials lies only in the contents of the vial. The language of claim 1 does not positively recite the presence of the particular medicament disclosed by applicant. The claim merely recites that the chamber is "filled with..." a substance, meaning that the chamber may be alternately filled with another substance depending on what medicament is desired by the end user. It would have been obvious to one having ordinary skill in the art at the time the invention was made to fill the chamber of the vial disclosed by Crankshaw with the solution claimed by applicant, since it has been held to be within the general skill of a worker in the art to select a known material (such as a known medicament) on the basis of its suitability for the intended use (such as to treat a particular illness) as a matter of obvious design choice. See MPEP § 2144.07.

Applicant also argues that the prior art does not disclose that the vial acts to reduce the medicament's exposure to oxygen in the chamber. The level to which the chamber is filled is a statement of the intended use of the device. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. See MPEP § 2114.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie R. Deak whose telephone number is 571-272-4943. The examiner can normally be reached on M-F 7:30-5:00, every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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PATRICIA BIANCO
PRIMARY EXAMINER
3/13/06


Leslie R. Deak
Patent Examiner
Art Unit 3761
7 March 2006